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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,568	01/16/2002	Xavier Blin	05725.1018-00	1780

7590

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EXAMINER

VENKAT, JYOTHSNA A

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/046,568

Applicant(s)

BLIN ET AL.

Examiner

JYOTHSNA A VENKAT

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 49-105 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 98 is/are allowed.
- 6) ☒ Claim(s) 49-97 and 99-105 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9/10/03.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

Receipt is acknowledged of RCE, IDS and remarks filed on 9/10/03. Claims 49-105 are pending in the application and the status of the application is as follows:

**Upon careful review of applicants remarks the 102(b) rejection is withdrawn as the claims are intended for nail polish use only.**

#### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 49-97 (**99-105**) are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patent 6,402, 408 ('408) and Harry's Cosmetology by Ralph Harry pp 375-383.

The instant application is claiming a structured nail polish composition comprising:

1. *At least one liquid organic phase comprising:*

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*a. Volatile organic solvent*

*b. First polymer comprising;*

*i) A polymer backbone comprising hydrocarbon-based repeating units, wherein the e unit has one heteroatom*

*ii) At least one fatty chain containing 6-12 carbon atoms and chosen from at least one pendent fatty chain and one terminal fatty chain where in the fatty chain is linked to the hydrocarbon-based units and is optionally functionalized*

*2. Second film-forming polymer (species is claimed in claim 74)*

*3. The organic phase additionally has non volatile oil*

*4. Additives in claim 88.*

The patent '408 teaches ingredients 1a,b and 3-4. The patent teaches 1a where in the volatile oil is isoparaffin and isododecane claimed in claims 80-81 at col.6, lines 28-29. The patent teaches the compositions as stick and its application in the field of nails. See cols. 3-4 for the polymer, which is the same, claimed in claim 62. See also col.7, lines 10-20 for the various additives, see the same column, lines 49-50 for the application on the nails, see also col.5 penultimate paragraph for the compositions in the form of stick, see col.6 lines 10-15, and 35 for the non-volatile oil. The difference is the patent does not teach ingredient 1a volatile organic solvent, which is claimed in claim 79, or the second film-forming polymer. However, the Harry's Cosmetology teaches 1a and 2. See page 376 for ingredient 2 and see page 379, table for 1a, which is claimed, in claim 79.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of '408 and combine it with the film-forming

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*polymer* of 'cosmeticology, expecting beneficial effect to the nail. The idea of combining the ingredients flows logically from the art for having been used in the same nail care art. One of ordinary skill in the art would have reasonable amount of success that by using the polymer in the form of a stick posses the properties of deformable, flexible and have flexibility and by combining it with the conventional nail polish instead of the conventional nail polish in a bottle. It is a prima facie case of obviousness.

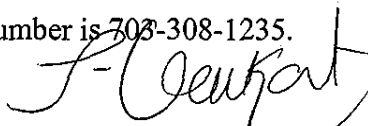
**Applicants are notified that the instant application is captured electronically.**

**Claims 99-105 are not present in the application. Claim 98 drawn to the process is allowable and the dependent claims if depend on the process of use are allowable. If they depend on the composition they are not allowable over the art cited above.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT whose telephone number is 703-308-2439. The examiner can normally be reached on Monday-Thursday, 9:30-7:30:1st and 2nd Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 703-308-2927. The fax phone number for the organization where this application or proceeding is assigned is 703-305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

  
**JYOTHSNA A VENKAT**  
Primary Examiner  
Art Unit 1615

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